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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,500	04/30/2001	William Grey	101.019	2096

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,500

Applicant(s)

GREY ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 25, 26 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 25, 26 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant: Grey et al.

Filing date: 4/30/2001

Claim Rejections - 35 USC § 112

Claims 19 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 19 is dependent on claim 15, which does not mention an identification card. This claim will be treated as dependent on claim 16 for the purposes of this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-15, 25-26 and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #5,206,490 to Petigrew et al. ("Petigrew" hereinafter). Petigrew discloses an item 1, comprising:

an item surface 15; and

a plurality of machine-readable item codes 5, 6 printed on the item surface, the plurality of item codes 6, 7 being associated with the item and substantially invisible to a human (see column 3, lines 23-47, column 4, lines 26-43, and elsewhere).

Re claim 3, it is clear from this passage and elsewhere in the reference that the codes will be the same.

Re claim 14, it is clear from figure 1 that the item has at least two sides. In fact, from the perspective in figure 1, it appears that the item has 7 sides, two of which have bar codes. Moreover, the description at column 3, line 46 describes the "entire packaging" carrying bar codes. The "entire packaging" inherently includes all sides capable of containing an invisible bar code.

Re claim 15, the patent talks about the invisible information not obscuring the visible markings. See also figure 1.

Re claims 25, 26, see column 4, line 26 through column 6, line 6.

5 Claims 16-17 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5,418,855 to Liang et al. ("Liang" hereinafter). Liang discloses an identification card associated with a card-holder, comprising:

an identification card surface (see figure 6);

visible information 31 printed on the identification card surface; and

10 a machine-readable code 31 printed on the same area of the identification card surface as the visible information, the code being associated with the card holder and substantially invisible to a human (see especially figure 6, and column 8, lines 26-69).

Re claim 19, the card also contains area 32, which contains a magnetic code. Magnetic code is invisible to humans. (See also the remark at column 6, lines 47-49).

15 Claims 1-6, 8-13, 15-17, 19, and 25 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent #5,471,533 to Wang et al. ("Wang" hereinafter). Wang discloses an item, specifically an identification card, passport, bearer bond, etc., associated with a card-holder, comprising:

20 an identification card surface (see figure 1A);

visible information 20 printed on the identification card surface; and

 a machine-readable code 18 printed on the same area of the identification card surface as the visible information, the code being associated with the card holder and substantially invisible to a human (see especially column 4, lines 1-5).

25 Re claim 19, the card contains a plurality of codes in a plurality of rows, the codes indicating the identity of the holder, whether the holder was allowed to drive without corrective lenses, etc. See column 4, lines 6-38.

Re claim 1, 4, the item is the identification card, passport, stock certificate, etc. The plurality of codes are alternatively related to the picture contained on the identification card.

They may indicate the color of the hair, the eye color, etc.

Re claim 5, the row numbers are sequence numbers that allow the information in the rows to be combined intelligently. They are meta-data, or data about the data.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Wang in view of Liang. Wang teaches the features of the invention, but does not teach the encoding of invisible codes using different techniques. Liang teaches that different techniques may be used to encode information 31, 32, in order to code the information, because "[t]he security of the authentication scheme is enhanced by using multiple codes. The multiple codes can be combined in various ways unknown to a potential counterfeiter or unauthorized user of the article in question," as taught by Liang at column 8, lines 49-53.

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Claims 4-5 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Petigrew in view of U.S. Patent #5367,148 to Storch et al. ("Storch" hereinafter), U.S. Patent #5,271,642

to Jahier et al. ("Jahier" hereinafter), and U.S. Patent #4,889,367 to Miller ("Miller" hereinafter). Petigrew teaches the features of the invention as described above, but does not teach that a plurality of item codes may be used to encode different information. Storch, Jahier, and Miller are cited as examples of package labels which may be used to encode different information about an item, besides the UPC product code, such as quality control information, supplier, serial number, price, and/or other inventory information. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teachings of Petigrew with the teachings of Jahier, Miller, and Storch because Petigrew teaches the secure scanning of an item for information about the item, and Jahier, Miller, and Storch teach that items may have more information which may be encoded and scanned, such as quality control, supplier, price, and serial number, using a plurality of codes.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #4,538,059 to Rudland is cited for showing another invisible coding system for ID cards with a plurality of invisible codes. See figures 4 and 7b.

Remarks

Applicant is applying for patent in a crowded art, as evidenced by the 4 separate 35 U.S.C. § 102 rejections in the first Office Action. Finding any broad patentable claims in this field is unlikely, in the Examiner's opinion.

Response to Arguments

Applicant's arguments with respect to claims 1-17, 19, 25-26 and 29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after
5 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner,
15 Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

August 13, 2003